

U.S. Serial No. 09/941,881

Reply to Office Communication Dated: 3/2/2004

Page 5 of 7

Family Number: P2001J056

REMARKS

Claim 6 remains in the instant application, while claims 1-5 and 7-44 were cancelled from this case. No new matter has been added.

The Examiner issued a Restriction Requirement, under 35 U.S.C. § 121, for three inventions: Group I (claims 1-5) is drawn to compounds in class 556, subclass 33 inter alia; Group II (claims 6-12) is drawn to a catalyst composition in class 502, subclass 167; and Group III (claims 13-44) is drawn to an olefin polymerization method in class 526, subclass various depending on the cocatalyst used. Applicants provisionally elected Group II (claims 6-12) with traverse on August 6, 2002, in a telephone conversation with the Examiner. Claims 1-5 (Group I) and claims 13-44 (Group III) were withdrawn from further consideration by the Examiner pursuant to 37 CFR § 1.142(b) as being drawn to a non-elected invention. Applicants hereby affirm the provisional election of Group II (claims 6-12) with traverse and have cancelled claims 1-5 (Group I) and claims 13-44 (Group III) from the instant application.

Applicants have amended two parts of the specification, as shown in the Amendments to the Specification section hereinabove, for clarification reasons. In the first instance, the structure on the bottom left-hand corner of page 8 of the original specification was identified as "4,4',4"-tri-*tert*-butyl-2,2':6',2'-terpyridine" when it should actually read -- 4,4',4"-tri-*tert*-butyl-2,2':6',2"-terpyridine --. In the second instance, this same amendment occurs in the paragraph describing Example 15 on pages 24-25 of the specification. Support for this amendment is found in the structure shown above line 10 on page 6 of the application and in original claim 5.

U.S. Serial No. 09/941,881
 Reply to Office Communication Dated: 3/2/2004
 Family Number: P2001J056

Page 6 of 7

Claim 10 was deemed allowable by the Examiner over the prior art of record. Applicants have amended independent claim 6 to incorporate the limitations from dependent claims 9 and 10, such that claim 6 should now be in allowable form.

Claims 6-12 were rejected under the first paragraph of 35 U.S.C. § 112 because the specification allegedly "does not reasonably provide enablement for their being 'any other moiety into which a monomer can insert' or 'any other neutral coordinating ligand.'" Claim 6, the only remaining claim in this case, has been amended so that the objectionable statements are not taught therein. Thus, this rejection should be obviated and kindly removed.

Claims 6-12 were also rejected under the second paragraph of 35 U.S.C. § 112 as being "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner alleged that "it is not clear [in claim 10] that in the first compound recited[,] the colon is supposed to be in its name." In response, applicants confirm that the colon in amended claim 6, which incorporates the limitations from claim 10, is correct in identifying the ligand L. As for the objection to the phrases "any other moiety into which a monomer can insert," "any other neutral coordinating ligand" and "a monomer," the present amendments to claim 6 rectify these rejections. And the objection to claim 11 is now moot. Hence, this rejection should now be obviated and kindly removed.

Claims 6, 7 and 9 were rejected under 35 U.S.C. § 102(a) as being anticipated by the Davis reference. The instant amendment of claim 6 and cancellation of claims 7 and 9 obviate this rejection, so this rejection should now be properly removed.

Claims 6-9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by both Stibrany, et al. (WO 99/30822) and van Baar, et al. (WO


U.S. Serial No. 09/941,881
Reply to Office Communication Dat d: 3/2/2004
Family Number: P2001J056

Page 7 of 7

00/35974). The instant amendment of claim 6 and cancellation of claims 7-9 and 11-12 obviate these two rejections, so these rejections should now be properly removed.

In view of the foregoing comments and amendments, applicants kindly request reconsideration of the application. Applicants believe the case is now in condition for allowance and respectfully request the Examiner to pass the case to issue at an early date.

Respectfully submitted,



Joseph C. Wang
Attorney for Applicants
Registration No. 44,391
Telephone Number: (908) 730-3665
Facsimile Number: (908) 730-3649

☒ Pursuant to 37 CFR 1.34(a)

ExxonMobil Research and Engineering Company
P. O. Box 900
Annandale, New Jersey 08801-0900

JCW:kak
May 27, 2004